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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,143	02/11/2004	Atsuo Tanaka	114011.01	2443

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EXAMINER	
NGUYEN, CHAU N	
ART UNIT	**PAPER NUMBER**
2831	

DATE MAILED: 01/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

H·A

Office Action Summary	Application No.	Applicant(s)	
	10/775,143	TANAKA, ATSUO	
	Examiner	Art Unit	
	Chau N Nguyen	2831	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 December 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-5 and 7-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Imamura et al. (JP6-84411) in view of in view of Mori (4,268,714).

Imamura et al. discloses a flat shield cable comprising a plurality of parallel signal lines, each of the lines having an insulating cover, a drain line disposed on a first side of the signal lines, a dummy line disposed on a second side of the signal line (Fig. 1), a shield layer (12) covering the signal lines, the drain line and the dummy line, wherein the plurality of signal lines, the drain line and the dummy line are co-planar.

Imamura et al. does not disclose the shielding tape including a metal foil, a polymer layer and an adhesive film, the metal foil being adjacent the signal lines, the polymer layer being adjacent the metal foil and the adhesive film being

adjacent the polymer layer nor an insulating sheath covering the shield layer. Mori discloses a shielding tape (Figure 5a) including a metal foil (41), a polymer layer (42) and an adhesive film (43), the polymer layer being adjacent to the metal foil, and the adhesive film being adjacent to the polymer layer. It would have been obvious to one skilled in the art to use the shielding tape as taught by Mori for the shielding layer (12) of Imamura et al., with the metal foil adjacent the signal lines, to secure the shielding tape within the cable because of the adhesive film. It would also have been obvious to one skilled in the art to cover the shielding tape of Imamura et al. with an insulating sheath to protect the cable core from the environment since using an insulating sheath to protect the cable core is known in the art.

The modified cable of Imamura et al. also discloses the dummy line being made of a metal (re claim 2), the diameter of the dummy line being greater than the diameter of each signal line core (re claims 3 and 4), the metal foil being made of aluminum (re claims 7, 10 and 13). Re claims 5, it would have been obvious to one skilled in the art to use aluminum for the dummy line of Imamura et al. since aluminum is known in the art for its high tensile strength and corrosion-resistant. Re claims 8, 9, 11, 12, 14 and 15, it would have been obvious to one skilled in the art to choose suitable thicknesses for the metal foil, the polymer layer and the

adhesive film respectively along with the cross-section area for the dummy line and the core conductor of Imamura et al. to meet the specific use of the resulting cable since it has been held that where the general conditions of a claim are disclosed in prior art, discovering the optimum or workable range involves only routine skill in the art. *In re Aller* 105 USPQ 233.

3. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Imamura et al. in view of Mori as applied to claim 3 above, and further in view of Tsao et al. (6,444,902).

The modified cable of Imamura et al. discloses the invention substantially as claimed except for the dummy line having a diameter greater than the diameter of the drain line. Tsao et al. discloses a flat shield cable comprising (ground) metal wires in which one (14) of the wires has a diameter greater than other (16) of the wires and a shield tape including aluminum foil. It would have been obvious to one skilled in the art that depending on the specific use of the resulting cable, to apply the teaching of Tsao et al. in the Imamura et al. cable, such as providing the dummy line with a greater diameter, since the greater diameter of the wire would further support the cable strength.

Response to Arguments

4. Applicant's arguments filed Dec. 3rd 2004 have been fully considered but they are not persuasive.

Applicant primarily argues that there is no motivation to combine the references, the office action has not established a *prima facie* case of obviousness, and the claimed dimensions are not taught in the cited references. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the suggestion to do so is found in the references themselves, see Mori, col. 3, lines 35-38. In response to applicant's argument that the office action has not established a *prima facie* case of obviousness, it has been found that the examiner's burden of establishing *prima facie* obviousness is satisfied by a showing of structural similarity between the claims and prior art, it does not require a showing of some suggestion or expectation in the prior art that the structurally similar

subject matter will have the same or a similar utility as that discovered by the applicant. In re Dillon, 16 USPQ 2d 1897. Finally, as mentioned in the office action that where the general conditions of a claim are disclosed in prior art, discovering the optimum or workable range involves only routine skill in the art. *In re Aller* 105 USPQ 233.

Summary

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Communication

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chau N Nguyen whose telephone number is 571-272-1980. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard can be reached on 571-272-2800 ext 31. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chau N Nguyen
Primary Examiner
Art Unit 2831